

## **REMARKS**

Claims 1-10 are currently pending and stand rejected. By way of this Response, claims 5, 9 and 10 have been amended. No new matter is presented by way of this amendment.

### **I. Acknowledgement of Foreign Priority Under 35 U.S.C. § 119(a)-(d).**

The Applicants recognize the Office's acknowledgement of foreign priority under 35 U.S.C. § 119(a)-(d) of Application No. DE 103 13 760.2, filed on March 27, 2003.

### **II. Amendment of Abstract.**

The Office objected to the abstract as being in excess of 150 words. Applicants have prepared a new abstract below to replace the abstract previously submitted.

The present invention relates to a package containing medical liquids, particularly infusion, transfusion or enteral bags, comprising a connecting part (1) for a spike to draw out liquids and a closure part (3) that closes the passage (2) inside the connecting part (1). The connecting part (1) has an elastically deformable pinching off part (4) in the form of a tubular section with a noncircular cross-section. A base part (5), widening on both sides, is adjoined to said pinching-off part (4) and can be integrated in the packing. During manufacturing, the packing is filled via the connecting part, then the pinching-off part is pressed together preventing liquid from escaping. Afterward, the closure part is placed onto the connecting part. The manufacturing of the packing is simplified by rendering unnecessary an additional tube for connecting the connector and packing.

### **III. The Objection For Multiple Independent Claims Should be Withdrawn.**

The Office objected to claims 5-10 under 37 C.F.R. § 1.75(c) as being in an improper form because claim 5 was a multiple dependent claim. Applicants have amended claims 5, 9 and

10 to conform with 37 C.F.R. § 1.75(c) and MPEP § 608.01(n). Therefore, Applicants respectfully request this objection be withdrawn.

#### **IV. The Rejection Under 35 U.S.C. § 102 Over U.S. Patent No. 6,364,143 (“Knierbein”) Should Be Withdrawn.**

The Office rejected claim 1 as anticipated under 35 U.S.C. § 102 over Knierbien. To establish anticipation, the Federal Circuit has stated that it “requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *see also* MPEP § 2131. It is not enough, however, that the prior art reference disclose all the claimed elements in isolation. Rather, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). Furthermore, “[t]he identical invention must be shown in as complete detail as contained in the...claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

Applicants respectfully submit that a case for anticipation has not been established as Knierbein fails to disclose each and every element of claim 1. The Application discloses a container comprising an elastically deformable pinching-off part with a noncircular cross-section.

In contrast, the connector described in Knierbein comprises a connector with a tubular upper part with an external threading for screwing onto a coupler nut. (Knierbein 3:41-43.) In order to be able to be screwed into the coupler nut, as described in Knierbein, the upper tubular part cannot be elastically deformable. Additionally, given that the connecting part described in Knierbein screws into the coupler nut, it cannot have a noncircular cross-section, since such a noncircular cross-section would prevent the formation of a seal. Further, in describing Knierbein

as disclosing a noncircular cross-section, the Applicants respectfully submit that the Office has misread Knierbein. Specifically, the radially projecting wing-like pieces (*Id.* 7 and 8 in Fig. 1) do not form the “connecting part” of the connector disclosed by Knierbein. Rather, these radially projecting wing-like pieces form the base part of the connector, linking the connector to the container. In contrast, in the Application, the actual connecting part has the noncircular cross-section.

As such, Knierbein fails to disclose each and every element of independent claim 1. Applicants respectfully request the rejection under 35 U.S.C. § 102 based upon Knierbein be withdrawn.

**V. The Rejection Under 35 U.S.C. § 103 over Knierbein in View of U.S. Patent No. 5,494,170 (“Burns”) Should Be Withdrawn.**

The Office rejected dependent claims 2-4 as obvious under 35 U.S.C. § 103 over Knierbein in view of Burns. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be an apparent reason why a person of ordinary skill would have combined the prior art elements in the manner claimed. Second, there must be a reasonable expectation of success. Third, the references, when combined, must teach or suggest all the claim limitations. *See* Memorandum from Margaret A. Focarino to USPTO Technology Center Directors dated May 3, 2007; M.P.E.P. § 2143. The burden of establishing a *prima facie* case of obviousness lies with the PTO. In determining obviousness, one must focus on the invention as a whole. *Symbol Technologies Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1577-78 (Fed. Cir. 1991). The primary inquiry is: “[w]hether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have had a reasonable likelihood of success .... Both the suggestion and the expectation of success must be found in the prior art, not the applicant’s disclosure.” *In re Dow Chemical*, 837 F.2d 469, 473 (Fed. Cir. 1988).

The Office submits that Burns discloses a snap fit and a self-sealing membrane. The Office also submits that it would have been obvious for one of ordinary skill in the art to combine the teachings of Knierbein and Burns.

As previously discussed, Knierbein fails to teach each and every element of independent claim 1. Moreover, the Office fails to contend that Burns discloses the limitation in claim 1 of a container comprising an elastically deformable pinching-off part with a noncircular cross-section. Therefore, even if Burns and Knierbein were combinable, which the Applicants deny, Burns and Knierbein in combination fail to disclose all the elements of independent claim 1, upon which claims 2 through 4 depend.

Based on the above, the Applicants respectfully submit that the Office's rejection of claims 2-4 as obvious under 35 U.S.C. § 103(a) over Knierbein in view of Burns should be withdrawn.

## **CONCLUSION**

For at least the foregoing reasons, it is respectfully submitted that Claims 1-10 are in condition for allowance. Early and favorable consideration is respectfully requested, and the Examiner is encouraged to contact the undersigned with any questions or to otherwise expedite prosecution.

Further, none of Applicant's amendments or cancellations are to be construed as dedicating any such subject matter to the public, and Applicant reserves all rights to pursue any such subject matter in this or a related patent application.

Respectfully submitted,

/ Lawrence S. Pope /

Lawrence S. Pope

Reg. No. 26,791

Date: March 26, 2008

### **CUSTOMER NUMBER 26565**

Mayer Brown LLP

P.O. Box 2828

Chicago, Illinois 60690-2828

312-701-8286